

REPLY

Serial No. 09/973,862
Atty. Docket No. GP095-06.DV4

Remarks

Claims 23-56 are pending in the subject application. Claims 25, 31 and 41 are withdrawn.

Reconsideration and allowance are respectfully requested in view of the above amendments to the claims and the following remarks.

Applicants note with appreciation the Examiner's withdrawal of the election of species requirement set forth in the Office Action mailed on June 3, 2005.

Objection to Declaration

The Examiner contends that the Declaration is defective because inventor Donald Nieglos amended his address information "with an initial." Applicants submit that Donald Nieglos did not amend either the residence or the post office address provided under his name in the Declaration. Instead, it would appear that the Examiner intended to refer to changes made to the residence and post office addresses of inventor Robert Schneider, which information was correctly identified in the Application Data Sheet filed simultaneously with Applicants' Declaration. See Attachment A. And pursuant to 37 C.F.R. § 1.76(d)(2), "[t]he information in the application data sheet will govern when the inconsistent information is supplied at the same time by a § 1.63 or § 1.67 oath or declaration," unless such information relates to inconsistencies in the naming of inventors. Accordingly, withdrawal of this objection is respectfully requested.

Rejection Under 35 U.S.C. § 112

Claims 23, 24, 26-30, 32-40 and 42-56 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants respectfully traverse this rejection for the reasons that follow.

The Examiner first submits that "it is unclear how a part of a device or an apparatus is one or more transport mechanisms since one or more transport mechanisms may be method steps."

Page 8 of 10

REPLY

Serial No. 09/973,862
Atty. Docket No. GP095-06.DV4

However, the Examiner has provided no reasoning to suggest how a transport mechanism may be method steps. To the contrary, the phrase "transport mechanism" clearly and unambiguously conveys that the recited structure is a device that can carry a reaction receptacle between stations of the claimed system. *See* Attachment B, dictionary definition of the term "mechanism."

Second, the Examiner contends that the phrase "may be present in a fluid sample" in the preamble is indefinite because it is unclear whether the target nucleic acid sequence is present in the sample. Since the currently pending claims are system claims rather than process claims, Applicants submit that whether the target nucleic acid is actually present in a fluid sample to be processed by the system is irrelevant. Nevertheless, Applicants have amended the preamble of claim 23 herein to recite that the claimed system is for "isolating and amplifying a target nucleic acid sequence present in a fluid sample."

For the reasons presented above, withdrawal of the Examiner's rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Conclusion

Applicants submit that the subject application is in condition for allowance, and early notice to that effect is earnestly solicited.

Please charge any fees due in connection with this Reply to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

REPLY

Serial No. 09/973,862
Atty. Docket No. GP095-06.DV4

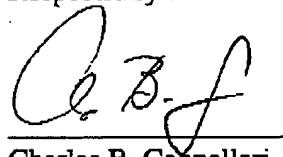
Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached) is being sent by facsimile to 571-273-8300 on the date indicated below to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

Date: October 5, 2005

By:



Charles B. Cappellari
Registration No. 40,937
Attorney for Applicants

GEN-PROBE INCORPORATED
Patent Department
10210 Genetic Center Drive
San Diego, California 92121
PH: 858-410-8927
FAX: 858-410-8928

ATTACHMENT A

SUPPLEMENTAL APPLICATION DATA SHEET

Inventor Information

Inventor One Given Name:: Kelly G.
Family Name:: AMMANN
Name Suffix::
Postal Address Line One:: 656 Wade Road
Postal Address Line Two::
City:: Longmont
State or Province:: Colorado
Country:: USA
Postal or Zip Code 80503
Citizenship Country:: USA

Inventor Two Given Name:: Ralph E.
Family Name:: BURNS
Name Suffix::
Postal Address Line One:: 302 27th Street
Postal Address Line Two::
City:: Boulder
State or Province:: Colorado
Country:: U.S.A.
Postal or Zip Code 80303
Citizenship Country:: U.S.A.

Inventor Three Given Name:: Ernest V.
Family Name:: HANSBERRY
Name Suffix::
Postal Address Line One:: 29435 Roon Drive
Postal Address Line Two::
City:: Evergreen
State or Province:: Colorado
Country:: U.S.A.
Postal or Zip Code 80439
Citizenship Country:: U.S.A.

Inventor Four Given Name:: Glenn A.
Family Name:: HORNER
Name Suffix::
Postal Address Line One:: 715 Zamia Court
Postal Address Line Two::
City:: Boulder
State or Province:: Colorado
Country:: U.S.A.
Postal or Zip Code 80304
Citizenship Country:: U.S.A.

Inventor Five Given Name:: Cheryl A.
Family Name:: JAKUB
Name Suffix::

Postal Address Line One:: 10792 Emanuael Way
Postal Address Line Two::
City:: Golden
State or Province:: Colorado
Country:: U.S.A.
Postal or Zip Code 80403
Citizenship Country:: U.S.A.

Inventor Six Given Name:: John E.
Family Name:: KLING
Name Suffix::
Postal Address Line One:: 14247 Barnabe Court
Postal Address Line Two::
City:: San Diego
State or Province:: California
Country:: U.S.A.
Postal or Zip Code 92129
City of Residence:: Boulder
State or Prov. of Residence:: Colorado
Country of Residence:: U.S.A.
Citizenship Country:: U.S.A.

Inventor Seven Given Name:: Donald J.
Family Name:: NIEGLOS
Name Suffix::
Postal Address Line One:: 1474 East Weldon Way
Postal Address Line Two::
City:: Superior
State or Province:: Colorado
Country:: U.S.A.
Postal or Zip Code 80027
Citizenship Country:: U.S.A.

Inventor Eight Given Name:: Robert E.
Family Name:: SCHNEIDER
Name Suffix::
Postal Address Line One:: 2777 Hughs Drive
Postal Address Line Two::
City:: Erie
State or Province:: Colorado
Country:: U.S.A.
Postal or Zip Code 80516
Citizenship Country:: U.S.A.

Inventor Nine Given Name:: Robert J.
Family Name:: SMITH
Name Suffix::
Postal Address Line One:: 889 Larkspur Court
Postal Address Line Two::
City:: Louisville
State or Province:: Colorado
Country:: U.S.A.
Postal or Zip Code 80027

Citizenship Country:: U.S.A.

Correspondence Information

Correspondence Customer Number:: 21365

Application Information

Title Line One:: AUTOMATED DIAGNOSTIC ANALYZER AND METHOD
Title Line Two::
Title Line Three::
Title Line Four::
Title Line Five::
Title Line Six::
Title Line Seven::
Total Drawing Sheets:: 46
Formal Drawings?:: Yes
Application Type:: Utility
Docket Number:: 2599-104-D4

Secrecy Order in Parent Appl?:: No

Representative Information

Representative Customer Number:: 6449

Continuity Information

This application is a:: Divisional of

>Application One:: 09/303,030
Filing Date:: April 30, 1999
Patent Number::

whichwhich is a:: Non-Provisional of Provisional

>>Application Three:: 60/083,927
Filing Date:: May 1, 1998
Patent Number::

ATTACHMENT B

Second College Edition

The
American Heritage
Dictionary

Words that are believed to be registered trademarks have been checked with authoritative sources. No investigation has been made of common-law trademark rights in any word, because such investigation is impracticable. Words that are known to have current registrations are shown with an initial capital and are also identified as trademarks. The inclusion of any word in this Dictionary is not, however, an expression of the Publisher's opinion as to whether or not it is subject to proprietary rights. Indeed, no definition in this Dictionary is to be regarded as affecting the validity of any trademark.

Copyright © 1982, 1985, 1991 by Houghton Mifflin Company. All rights reserved.

No part of this work may be reproduced or transmitted in any form or by any means, electronic or mechanical, including photocopying and recording, or by any information storage or retrieval system without the prior written permission of Houghton Mifflin Company unless such copying is expressly permitted by federal copyright law. Address inquiries to Permissions, Houghton Mifflin Company, 2 Park Street, Boston, MA 02108.

Library of Congress Cataloging in Publication Data
Main entry under title:

American Heritage dictionary.

Rev. ed. of: American Heritage dictionary of the English language. New college ed. c1976.

1. English language—Dictionaries. I. Morris. William, 1913—

PE1625.A54 1982 423 82-9346

ISBN 0-395-32943-4

ISBN 0-395-32944-2 (thumb index)

ISBN 0-395-33959-6 (deluxe edition)

Manufactured in the United States of America

foresight. Significance stresses meaning beyond immediate comprehension (underlying or long-range meaning); besides perception, it implies evaluation. In contrast, *signification* and *acceptation* apply to accepted or established meaning, directly conveyed. *Import* also pertains to ostensible meaning. *Purport* applies to broad understanding, often of an extensive subject.

meaningful (mē'ning-fəl) *adj.* Having meaning, function, or purpose; significant. —*mean'ing-ful-ly adv.* —*mean'ing-ful-ness n.*

mean-ing-less (mē'ning-lis) *adj.* Having no meaning or significance; senseless. —*mean'ing-less-ly adv.* —*mean'ing-less-ness n.*

mean-ly (mē'n-lē) *adv.* In a poor, mean, or base manner.

mean-ness (mē'n-nis) *n.* 1. The state of being inferior in quality, character, or value; commonness. 2. Selfishness; stinginess. 3. A spiteful or malicious act.

mean solar day *n.* The period of time between two successive transits of the mean sun; the standard for the 24-hour day, measured from midnight to midnight.

mean square *n.* The arithmetic mean of the squares of a set of numbers.

mean sun *n.* A hypothetical sun defined as moving at a uniform rate along the celestial equator so that it completes its orbit in the same period as the apparent sun, used in computing the mean solar day.

meant (mēnt) *v.* Past tense and past participle of *mean*.

mean-time (mē'n-tīm) *n.* The time between one occurrence and another; interval. —*adv.* During a period of intervening time; meanwhile: "Meanwhile, let wonder seem familiar" (Shakespeare).

Usage: *Meantime* serves principally as a noun: *In the meantime we waited.* In expressing the same sense as a single adverb, *meanwhile* is more common than *meantime*: *Meanwhile we waited.*

mean time *n.* Time measured with reference to the mean sun, giving equal 24-hour days throughout the year.

meanwhile (mē'n-wīl, -wīl) *n.* The intervening time. —*adv.* 1. During or in the intervening time: *Meanwhile, life goes on.* 2. At the same time: *The court is deliberating; meanwhile, we must be patient.* —*See Usage note at meantime.*

meas-les (mē'z-lis) *n.* (used with a *sing. verb*) 1. a. An acute, contagious virus disease, usually occurring in childhood and characterized by the eruption of red spots. b. Any of several diseases displaying similar but milder symptoms, esp. German measles. 2. A disease of cattle and swine, caused by tapeworm larvae. 3. A plant disease, usually caused by fungi, and producing minute spots on leaves and stems. [ME *measles*, pl. of *masel*, measles-spot, of MLG orig.]

meas-ly (mē'z-lē) *adj.* —*sl-er*, —*sl-est* 1. Infected or spotted with measles; measles. 2. *Slang.* Contemptibly small; meager: *a measly tip.*

meas-ur-a-ble (mē'z-ar-ə-bal) *adj.* 1. Able to be measured. 2. Of distinguished importance; significant: *a measurable figure in literature.* 3. Not so great as to escape all measure or comparison; moderate. —*meas'ur-a-bil'i-ty n.* —*meas'ur-a-bly adv.*

meas-ure (mē'z-ər) *n.* 1. The dimensions, quantity, or capacity of something as ascertained by measuring: *Length, area, volume, and mass are basic measures of material properties.* 2. A reference standard or sample used for the quantitative comparison of properties: *The standard kilogram is maintained as a measure of mass.* 3. A unit specified by a scale, as an inch, or by variable conditions, as a day's march. 4. A system of measurement, as the metric system. 5. A device, as a marked tape or a graduated container, used for measuring. 6. An act of measurement. 7. An evaluation or basis of comparison: *"the final measure of the worth of a society"* (Joseph Wood Krutch). 8. The extent or degree of something. 9. A fitting amount: *a measure of recognition.* 10. A limited amount or degree: *"a measure of serenity"* (John Updike). 11. Limit; bounds: *a generosity knowing no measure.* 12. Appropriate restraint; moderation: *criticism in measure.* 13. Often measures. An action taken as a means to an end; expedient: *desperate measures.* 14. A legislative bill or enactment. 15. Poetic meter. 16. *Mus.* The metric unit between two bars on the staff; bar. —*v.* —*ured*, —*uring*, —*ures*. —*tr.* 1. To ascertain the dimensions, quantity, or capacity of. 2. To mark, lay out, or establish dimensions for by measuring: *measure off an area.* 3. To estimate by evaluation or comparison: *"I gave them an account . . . of the situation as far as I could measure it"* (Winston Churchill). 4. To bring into opposition: *She measured her power with that of a dangerous adversary.* 5. To mark off, usually with reference to a given unit of measurement; dole out: *measure out a pint of milk.* 6. To serve as a measure of: *The inch measures length.* 7. To allot or distribute as if by measuring: *mete: The revolutionary tribunal measured out harsh justice.* 8. To consider or choose with care; weigh: *He measures his words with pedantic caution.* 9. *Archaic.* To travel over: *"We must measure much ground today"* (Shakespeare). —*intr.* 1. To have a measurement of: *The room measures 10 by 12 feet.* 2. To allow of measurement: *White sugar measures more easily than brown.* —*phrasal verb.* *measure up.* 1. To be the equal of. 2. To have the necessary qualifications: *a candidate who just didn't measure up.* —*idioms.* beyond

measure. 1. In excess. 2. Without limit. For good measure. In addition to the required amount. In a (or some) measure. To a degree: *The new law was in some measure harmful.* [ME < OFr. *mesure* < Lat. *mensura* < *metiri*, to measure.] —*meas'ur-er n.*

meas-ured (mē'z-əd) *adj.* 1. Determined by measurement: *The measured distance was less than a mile.* 2. Regular in rhythm and number: *"A clock struck slowly in the house with a measured, solemn chime"* (Thomas Wolfe). 3. Careful; restrained: *measured words.* 4. Calculated; deliberate: *with measured irony.* 5. Slow and stately. 6. Written in meter. 7. *Mus.* *Mensural.* 8. Limited: *a measured capacity for action.* —*meas'ured-ly adv.* —*meas'ured-ness n.*

meas-ure-less (mē'z-ər-lis) *adj.* Having no limits; infinite: *measureless happiness.* —*meas'ure-less-ly adv.*

meas-ure-ment (mē'z-ər-mənt) *n.* 1. The act of measuring or the process of being measured. 2. A system of measuring: *measurement in miles.* 3. The dimension, quantity, or capacity determined by measuring: *room measurements.*

measuring worm *n.* A geometrid caterpillar that moves in alternate contractions and expansions suggestive of measuring.

meat (mēt) *n.* 1. The edible flesh of mammals, as distinguished from that of fish or poultry. 2. An edible, fleshy, inner part: *crab meat.* 3. The edible portions of eggs, fruits, or nuts. 4. The essence or principal part of something: *the meat of the editorial.* 5. *Slang.* Something one enjoys or excels in; forte: *Tennis is his meat.* 6. Something eaten for nourishment; food: *meat and drink.* —*modifier:* *meat products.* [ME *mēt* < OE, food.]

meat-ball (mēt'bōl) *n.* 1. A small ball of ground meat variously combined and cooked. 2. *Slang.* A stupid, clumsy, or dull person.

meat-less (mēt'lis) *adj.* 1. Lacking meat or food. 2. Being or relating to a time when meat is not to be eaten: *meatless days.*

meat loaf *n.* A mounded or molded dish, usually baked, of ground beef or a combination of meats and other ingredients.

me-a-tus (mē'ā-tas) *n., pl. -tus-es or meat-us.* A body canal or passage, as the opening of the ear or the urethral canal. [Lat. *passage* < *meare*, to pass.]

meaty (mē'tē) *adj.* —*ier*, —*iest* 1. a. Of or pertaining to meat. b. Having the flavor or smell of meat. c. Full of or containing meat. 2. Heavily fleshed. 3. Supplying ample food for thought: *a meaty theme for study and debate.* —*meat'iness n.*

me-c-a-myl-a-mine (mek'ā-mīl'ā-mēn') *n.* A drug, C₁₁H₁₁NHCl, that is administered orally to bring down highly elevated blood pressure. [Orig. a trademark.]

me-c-ca (mek'ā) *n.* 1. a. A place that is regarded as the center of an activity or interest. b. A goal to which adherents of a religious faith or practice fervently aspire. 2. A place visited by many people: *a mecca for tourists.* [After Mecca, Saudi Arabia, from its being a place of pilgrimage.] —*meccan- pref.* Variant of *mechano-*.

me-chan-ic (mī-kān'ik) *n.* A worker skilled in making, using, or repairing machines and tools. [ME, *mechanical*, < OFr. *meccanicus* < Lat. *mechanicus* < Gk. *mēkhanikos* < *mēkhanē*, machine < *mēkhanōs*, means.] —*me-chan'ic-ly adv.*

me-chan-i-cal (mī-kān'ī-kəl) *adj.* 1. Of or pertaining to machines or tools. 2. Operated or produced by a machine. 3. Of, pertaining to, or governed by mechanics. 4. Acting or performing like a machine; automatic: *The speaker's delivery was mechanical.* 5. Pertaining to, produced by, or dominated by physical forces. 6. Interpreting and explaining the phenomena of the universe by referring to causally determined material forces; mechanistic. 7. Of or pertaining to manual labor, its tools, and its skills. —*n.* *Printing.* A layout consisting of type proofs, artwork, or both, exactly positioned and prepared for making an offset or other printing plate. [ME < *mechanic*, *mechanical*. —*see MECHANIC*] —*me-chan'i-cal-ly adv.* —*me-chan'i-cal-ness n.*

mechanical advantage *n.* The ratio of the output force of a machine to the input force.

mechanical drawing *n.* 1. Drafting. 2. A drawing, such as an architect's plans, that enables measurements to be interpreted.

mechanical engineering *n.* The branch of engineering that encompasses the generation and application of heat and mechanical power and the design, production, and use of machines and tools. —*mechanical engineer n.*

mech-a-ni-clan (mek'ā-nī-sh'ən) *n.* A person who makes, uses, or repairs machines and tools.

mechanics (mī-kān'iks) *n.* (used with a *sing.* or *pl. verb*) 1. The analysis of the action of forces on matter or material systems. 2. The design, construction, operation, and application of machinery or mechanical structures. 3. The functional and technical aspects of an activity: *The mechanics of football are learned with practice.*

***mech-a-nism** (mek'ā-nīz'm) *n.* 1. a. A machine or mechanical appliance. b. The arrangement of connected parts in a machine. 2. A system of parts that operate or interact like those of a machine: *the mechanism of the solar system.* 3. An instrument or process, physical or mental, by which

There are three Customary Syst (Metric) System.

The fundamen ships to derived quantities in other units of "weight (weight), and cap common units of

Measurement. The magni the magnitude of Quantities hav and independent

al." All other c "derived" from, is an example of

relationship between W is the weight, where the body i of the fundamen fundamental qua equation and are rather than mass resulting units as

There is an im "standard of n A unit of mea the magnitudes

A standard of tions, serves to. In the U.S. C the (avoirdupois U.S. System. Th in the Metric Sy tem, but they ar

The fundamen and the pound, I standard, as in t created specifica the United State and the Internati

(as given in Tab There are, how systems. In the same as those of the British Imper at a temperatur

bushel was defin still a legal, alth The Metric Sy

U.S. Customary

inch

foot

yard

rod

mile (statute, is

mile (nautical, International)

U.S. Customary

square inch

square foot

square yard

acre

square mile

U.S. Customary

square inch

square foot

square yard

acre

square mile

U.S. Customary

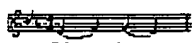
square inch

square foot

square yard

acre

square mile



measure
First measure of
"Frère Jacques"

ā pat / ā pay / ār care / ā father / b bib / ch church / d deed / ē pet / ē be / f life / g gag / h hat / hw which / i pit / i pie / i pier / j judge / k kick / l lid, needle / m mum / n no, sudden / ng thing / ō pot / ō toe / ō paw, far / ō noise / ou out / ōb took / ōb boot /

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.